

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

84517-US1

	Application Number 10/673351-Conf. #8470	Filed September 30, 2003
First Named Inventor Seán J Hart et al.		
Art Unit 1723	Examiner J. W. Drodge	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant /inventor.



Signature

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
is enclosed. (Form PTO/SB/96)

Thomas D. Robbins
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Registration number if acting under 37 CFR 1.34. 43,369

July 6, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of 1 forms are submitted.

Docket No.: 84517US1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sean J Hart et al.

Application No.: 10/673351

Confirmation No.: 8470

Filed: September 30, 2003

Art Unit: 1723

For: SEPARATION OF COLLOIDAL
SUSPENSIONS USING LASER OPTICAL
PRESSURE FLUIDIC DEVICES

Examiner: J. W. Drodge

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

A summary of the prosecution history of the above-identified application is as follows:

The Office action dated 12/19/2005 rejected original claims 1-9 (claim 10 was withdrawn as being directed to a non-elected invention) over Nishimura et al. (USPN 5,495,105), Zanger et al. (USPN 6,317,449) and two references by Wang et al. (USPN 6,815,664 and USPN 6,778,724).

The Applicants' response filed February 3, 2006, canceled claims 1-10 and added new claims 11-18 and presented arguments as to why the newly added claims are patentable over the prior art of record.

The final Office action dated March 22, 2006, rejected claims 11-18 as being anticipated by newly applied Dapprich (USPN 6,585,939).

Page 3, the second full paragraph of Applicants' after-final response filed June 12, 2006 (After Final Response), includes an argument that Dapprich fails to disclose:

"a fluid pathway arranged to permit flow of a fluid in a first direction therethrough and a light input part arranged to accept input light and permit the input light to travel into [sic] through the fluid pathway in a second direction opposite of the first direction, as required in the independent claims."

The advisory action dated 06/23/2006 indicates that the request for consideration has been considered but does NOT place the application in condition for allowance. The continuation sheet of the advisory action states that:

"[t]he Arguments presented in the Remarks are not persuasive. It is argued that Dapprich patent 6,585,939 fails to disclose a fluid pathway having a 'light input part' (such as a mirror or reflector) arranged to accept light from a first direction and permit such light to flow in a reverse direction. However, Dapprich discloses fluid-handling bodies such as sample holder 64 as forming a part of a microstructure in which samples are transported and dispersed, i.e. have fluid movement (see column 11, lines 59-65; column 12, lines 1-5, 10-20 and 65-67). Column 12, lines 22-26 then state that such microstructures may also comprise optical components including lenses, mirrors and other reflectors (column 12, lines 22-25 and 50-67)."

Applicants request that the Pre-Appeal examining group decide the following two issues:

1. does Dapprich disclose "a PDMS body having a fluid pathway arranged to permit flow of a fluid in a first direction therethrough" and "a light input part arranged to accept input light and permit the input light to travel into said PDMS body and through said fluid pathway in a second direction opposite of the first direction"; and
2. does Dapprich disclose "a body comprising a first material and having a fluid pathway arranged to permit flow of a fluid in a first direction therethrough," and "a light input part on said body and comprising a second material, said light input part being arranged to accept input light and permit the input light to travel into said body and through said fluid pathway in a second direction opposite of the first direction"?

It is respectfully submitted that Dapprich fails to disclose the above-identified limitations.

As pointed out on page 2, paragraph 3 of the After Final Response, an aspect of the present invention is drawn to a flowcell having a fluid pathway, for example as illustrated in Figure 2. A **fluid flows down the fluid pathway in a first direction whereas a light beam travels up the fluid pathway in a second direction opposite the first direction.** (Emphasis added) The light beam creates optical pressure on certain particles within the fluid in the pathway.

As pointed out on page 2, paragraph 4 of the After Final Response, each of independent claims 11 and 17 recites, *inter alia*,

“**a PDMS body having a fluid pathway arranged to permit flow of a fluid in a first direction therethrough**” and “**a light input part arranged to accept input light and permit the input light to travel into said PDMS body and through said fluid pathway in a second direction opposite of the first direction.**” (Emphasis Added)

As pointed out on page 2, paragraph 5 of the After Final Response, independent claim 13 recites, *inter alia*.

“**a body comprising a first material and having a fluid pathway arranged to permit flow of a fluid in a first direction therethrough,**” and “**a light input part on said body and comprising a second material, said light input part being arranged to accept input light and permit the input light to travel into said body and through said fluid pathway in a second direction opposite of the first direction.**” (Emphasis Added)

The advisory action seems to indicate that because a device disclosed in Dapprich is capable of accepting light from a first direction and permitting the light to flow in a reverse direction, then such a device anticipates the present invention. It is respectfully submitted that such an assertion is incorrect. Further, it seems that a misunderstanding of the claimed invention has erroneously led to the Examiner maintaining the final rejection of the pending claims.

Contrary to the assertion in the advisory action, the After Final Response **does not argue** that Dapprich fails to disclose “**a fluid pathway having a ‘light input part’ (such as a mirror or reflector) arranged to accept light from a first direction and permit such light to flow in a reverse direction.**” (Emphasis Added) The clear language of the claims and the arguments for patentability thereof are different than the position taken in the Advisory Action.

The present invention permits the fluid to travel in a direction that is opposite to the direction in which the light travels. Dapprich fails to disclose a fluid pathway arranged to permit fluid flow in a first direction and light to travel in a second direction opposite to the first direction.

In light of the above discussion, it is respectfully submitted that claims 11-18 are patentable over the prior art of record, an indication of which is solicited.

If there are any outstanding issues that can be resolved by a telephone interview, the examiner is asked to call the applicants' attorney Thomas D. Robbins at 202-404-1553.

Dated: July 6, 2006

Respectfully submitted,

By 
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